



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,057	08/30/1999	MICHAEL RUFFIN	PO9-98-157H	9966

7590 01/26/2005

Floyd A. Gonzalez
Intellectual Property Law
2455 South Road, P386
Poughkeepsie, NY 12601

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/386,057

Applicant(s)

RUFFIN ET AL.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1) In view of the reconsideration of the finality of the rejection filed on December 16, 2004, PROSECUTION IS HEREBY REOPENED. The non-final office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2) Applicant's arguments with respect to the rejection of claims 15-28 under 35 U.S.C. 101 and the prior art rejections of Claim 29 are persuasive and, therefore, the respective rejections of Claims 15-29 are withdrawn.

However, in response to the applicant's argument that Claim 1 recites the method carried out in a data processing system, the examiner respectfully traverses it. Although the preamble of Claim 1 recites the method carried out in a data processing system, there is no trace of the technological arts in the claim body to enable the entire method to perform data processing (e.g., no recitation of database, processor environment that determines and derives the cost and capacity measurement).

Without express recitation of the technological arts in the claim body, the method steps can be carried out by mere human interventions. If the method is truly directed to the data processing, as claimed by the applicant, there must be significant claim recitation of the data processing system or calculating computer.

Claim Rejections - 35 USC § 112

- 3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 4) Claims 3-7, 12-14, 17-21 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 3, line 3 and 6; and Claim 17, lines 3 and 6, respectively, the recitation of "any" renders the claim indefinite because it is not clear which available information should be provided by the method.

In Claim 5, line 2; and Claim 20, line 2, respectively, the recitation of "may" renders the claim indefinite because it is not clear whether the cost is actually provided or not.

Claim Rejections - 35 USC § 101

- 5) Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Please see the previous office action and the above examiner's response to the applicant's arguments.

Claim Rejections - 35 USC § 103

6) Claims 1-4, 8, 15-18, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strothmann (US 5,745,880) in view of Al-Hilali et al. (US 6,086,618).

As for Claim 1, Strothmann discloses a method comprising the steps of:

providing information on economical viability for a first computer platform prior to moving the migration (col. 1, lines 62-67; see Tables and the descriptions thereof);

determining a cost for hardware (e.g. CPU, memory, etc...) and software for the first computer platform and a second computer platform (see Figs. 2A-2c, Tables and the descriptions thereof);

determining an amount of functions to be migrated from the first platform to the second platform; and

deriving a cost for the first computer platform after the migration and for the second computer after the migration (see generally Tables and see Figs. 2A-2c, the descriptions thereof).

Although Strothmann considers a wide variety of cost factors, such as hardware and software, and predicts an optimum computer platform for processing of application functions (col. 2, lines 32-36), Strothmann does not expressly disclose the method including:

determining a required processing capacity for the both computer platform based on the usage information of both platforms;

Art Unit: 3629

determining an amount of the required processing capacity to be migrated from the first platform to the second one so as to derive the capacity measurement for the both platforms after migration.

Al-Hilali et al. teaches a method for estimating total resource usage requirement for any particular server applications (any computer platform that a system administrator wishes to monitor) and deriving a cost and capacity measurement based on the information on the usage for a particular computer platform (see col. 4, lines 1-10; col. 4, line 64 – col. 5, line 4; col. 5, lines 30-38; Figs. 4, Tables and descriptions thereof).

Since Al-Hilali et al. and Strothmann are both from the same field of endeavor of optimizing costs of processing of computer application functions, the purpose disclosed by Al-Hilali et al. would have been well recognized in the pertinent field of Strothmann.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to further take into account estimating total resource usage requirement for the first and second platforms prior to migration and accurately derive a cost and capacity measurement for the migration based upon the information on usage, as taught by Al-Hilali et al., for the purpose of assisting purchasers of new (second) computer platform in accessing system resource that needs for anticipated usage prior to migrating process (assist in making decision for the purchasers or users of the first computer platform with respect to cost and anticipated usage before purchasing the new, second computer platform).

As for Claim 2, the modified method of Strothmann further discloses the method, wherein the provided usage information include current and planned usage for the both platforms (see Tables of Strothmann for the current and planned costs and viability for the both first and second computer platforms and the modified method of Strothmann will include the usage information).

As for Claim 3, the modified method of Strothmann further discloses the method including:

- providing information on current and planned use of computers and computational workloads for the platforms (see Supra Claim 2 and col. 11, lines 15-35 and step 118 in Al-Hilali et al. for the workloads); and

- providing information on current and planned cost for the platforms.

As for Claim 4, the modified method of Strothmann further discloses the method, wherein the current and planned cost includes costs associated with hardware and software and support for both platforms (see both Strothmann and Al-Hilali et al. for taking into account Supra hardware, software and support).

As for Claim 8, the modified method of Strothmann further discloses the method, wherein the required processing capacity to be migrated is associated with the migration of one or more computational workloads from the first to second platform (see Strothmann's invention is directed to a system to evaluate movement of computer application functions from one to the other platform, and Al-Hilali et al. shows how to measure the workloads that are associated with the computer application functions).

As for Claim 15, the modified Strothmann discloses a program storage device embodying a program to perform method steps as recited in Supra Claim 1.

As for Claim 16, the modified device of Strothmann further discloses the method, wherein the provided usage information include current and planned usage for the both platforms (see Tables of Strothmann for the current and planned costs and viability for the both first and second computer platforms and the modified method of Strothmann will include the usage information).

As for Claim 17, the modified device of Strothmann further discloses the method including:

- providing information on current and planned use of computers and computational workloads for the platforms (see Supra Claim 2 and col. 11, lines 15-35 and step 118 in Al-Hilali et al. for the workloads); and

- providing information on current and planned cost for the platforms.

As for Claim 18, the modified device of Strothmann further discloses the method, wherein the current and planned cost includes costs associated with hardware and software and support for both platforms (see both Strothmann and Al-Hilali et al. for taking into account Supra hardware, software and support).

As for Claim 22, the modified device of Strothmann further discloses the method, wherein the required processing capacity to be migrated is associated with the migration of one or more computational workloads from the first to second platform (see

Art Unit: 3629

Strothmann's invention is directed to a system to evaluate movement of computer application functions from one to the other platform, and Al-Hilali et al. shows how to measure the workloads that are associated with the computer application functions).

As for Claim 29, Strothmann discloses a system comprising:

a storage base (inherently feature in every data processing system) for providing information on economical viability for a first computer platform prior to moving the migration (col. 1, lines 62-67; see Tables and the descriptions thereof);

means for determining a cost for hardware (e.g. CPU, memory, etc...) and software for the first computer platform and a second computer platform (see Figs. 2A-2c, Tables and the descriptions thereof);

means for determining an amount of functions to be migrated from the first platform to the second platform; and

means for deriving a cost for the first computer platform after the migration and for the second computer after the migration (see generally Tables and see Figs. 2A-2c, the descriptions thereof).

Although Strothmann considers a wide variety of cost factors, such as hardware and software, and predicts an optimum computer platform for processing of application functions (col. 2, lines 32-36), Strothmann does not expressly disclose the system including:

Art Unit: 3629

means for determining a required processing capacity for the both computer platform based on the usage information of both platforms;

means for determining an amount of the required processing capacity to be migrated from the first platform to the second one so as to derive the capacity measurement for the both platforms after migration.

Al-Hilali et al. teaches a method and system for estimating total resource usage requirement for any particular server applications (any computer platform that a system administrator wishes to monitor) and deriving a cost and capacity measurement based on the information on the usage for a particular computer platform (see col. 4, lines 1-10; col. 4, line 64 – col. 5, line 4; col. 5, lines 30-38; Figs. 4, Tables and descriptions thereof).

Since Al-Hilali et al. and Strothmann are both from the same field of endeavor of optimizing costs of processing of computer application functions, the purpose disclosed by Al-Hilali et al. would have been well recognized in the pertinent field of Strothmann.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize means for estimating total resource usage requirement for the first and second platforms prior to migration and accurately derive a cost and capacity measurement for the migration based upon the information on usage, as taught by Al-Hilali et al., for the purpose of assisting purchasers of new (second) computer platform in accessing system resource that needs for anticipated usage prior to migrating process (assist in making decision for the purchasers or users

Art Unit: 3629

of the first computer platform with respect to cost and anticipated usage before purchasing the new, second computer platform).

Allowable Subject Matter

7) Claims 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,192,470 is cited to show a system for providing price/performance normalization in determining an optimal computer configuration depending upon the user's specific applications.

US 5,668,995 is cited to show a computer-implemented capacity planning system for multiprocessor computer systems used in client/server environment.

US 5,832,274 is cited to show a method for migrating a file system and access rights associated with the file system from the first system to the second system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

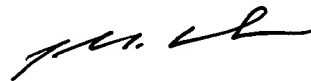
Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3629
January 21, 2005



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600